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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Fletcher et al.

Art Unit : 3653

Serial No. : 10/646,400

Examiner : J. Shapiro

Filed : August 22, 2003

Title : ADAPTABLE COIN MECHANISM

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY TO ACTION OF APRIL 13, 2004

In the Office action, claims 36-43 were rejected as unpatentable over the combination of U.S. Patent Nos. 5,056,643 (Kirberg) and 5,400,891 (Winstanley). As discussed below, applicant respectfully requests reconsideration.

The Law of Obviousness

A claimed invention is unpatentable due to obviousness if the differences between it and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person of ordinary skill in the art." 35 U.S.C. § 103(a).

As discussed by the Court of Appeals for the Federal Circuit, a proper conclusion of obviousness under 35 U.S.C. § 103 requires that there be some motivation in the prior art that suggests the claimed invention as a whole:

[A]n Examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit

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an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." [Citations omitted] To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show motivation to combine the references that create the case of obviousness.

In re Rouffet, 149 F.3d 1350, 1357; 47 USPQ2d 1453, 1457-1458 (Fed. Cir. 1998). As further explained by the Federal Circuit:

Our case law makes clear that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references. See *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight." *Id.*

"When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references." *In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998) (citing *In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987)).

Ecolochem, Inc. v. Southern California Edison Co., 56 USPQ2d 1065, 1072-73 (Fed. Cir. 2000). The showing of the motivation to combine must be "clear and particular." See, e.g., *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998); *Teleflex, Inc. v. Ficosa North Am. Corp.*, 63 USPQ2d 1374 at 1387 (Fed. Cir. 2002).

The Claimed Subject Matter is Patentable Over the Cited References

As discussed below, applicant submits that the Office action mischaracterizes the cited references in several significant ways. When the disclosures of the cited references are

understood properly, it is clear that the required "clear and particular" motivation to combine the references is lacking.

The Office action states (at pages 2-4):

Kirberg discloses the following claimed subject matter:

* * *

d. using a keypad (2) to enter a code that identifies the second arrangement of coin tubes to the coin validator;
(See col. 1, lines 29-34, which states that the machine of the prior art, and apparently also, Kirberg's apparatus, identifies the coin storing means as well as its type. See also col. 2, lines 28-30 and 34-38, noting that each coin storing means is intended to be used in several arrangements/configurations.)

* * *

k. entering a code through a keypad (2), wherein the code identifies a physical type of coin storing means/tube attached to a coin validator (note again, that the type of tube is identified to the machine through the code assigned to it).

Applicant respectfully disagrees. First, according to the Kirberg patent, the input keys 2 are intended for use by a "user" (col. 3, lines 3-4), not by service or repair personnel. It is clear from the patent that the term "user" refers, for example, to a customer who wishes to purchase a travel pass from the machine (*see, e.g.*, col. 3, lines 40 and 43). Therefore, the input keys 2 presumably allow such a "user" to make a selection from the machine. Those keys are not used by service personnel for entering codes or other information about the arrangement of the vending machine.

The Office action did not discuss the operator keyboard 15, which may be used to enter control commands and inputs. Applicant agrees, however, that the keyboard 15 also is not used to enter a code or other information about the coin tube. Indeed, there is absolutely no explanation in the Kirberg patent of what those control commands and inputs might be, and there is no reason to assume that the keyboard 15 would be used to enter a code identifying a coin tube. To the contrary, as discussed below, it is readily apparent from the Kirberg patent that it

contemplates that such information would be entered automatically, without the need for service personnel to enter the information manually (using keys or otherwise).

The Office action is correct that the Kirberg patent discloses (at col. 1, lines 29-34) providing the vending machine with (i) a “code number” that identifies the particular coin-storing means (*i.e.*, coin tube), and (ii) a “recognition signal” that identifies the type of coin storing means. However, the Office action is incorrect in its implication that such information would have been provided through use of keys or a keyboard. Instead, as explained below, it is readily apparent that such information likely would have been provided automatically when the coin-storing means (*i.e.*, coin tube) was installed in the vending machine.

According to the Kirberg patent, in the prior art, a unique code number that identified the particular coin-storing means was sent—in addition to the “recognition signal”—to the vending machine. However, such techniques had drawbacks (see col. 1, lines 41-59). Therefore, according to the Kirberg patent, the invention is directed to providing a unique code that identifies the vending machine. That code then is stored in memory of the coin-storing means. As explained by the Kirberg patent:

During placement of a respective coin-storing means 9 into a machine 1, a storing of the coding, for example, the machine number, that identifies the machine 1, in the electronic memory 20 of each coin-storing means 9 is effected automatically. (Col. 4, lines 23-27) (Emphasis added) Just as the code that identifies the vending machine is sent automatically when the coin-storing means is installed, one would expect that the “recognition signal” (col. 1, line 32) that identifies the type of coin storing means also is sent automatically.

In any event, regardless of how the “recognition signal” would have been sent, there is absolutely no suggestion in the Kirbeg patent of using input keys or keyboard to do identify the type of coin tube.

The Office action also refers to col. 2, lines 28-30 and 34-38, as indicating that each coin storing means is intended to be used in several arrangements or configurations. That is irrelevant and misleading.

The pending claims refer to the physical arrangement of cassette with multiple coin tubes. Different cassettes may have a different number or arrangement of multiple coin tubes.

In contrast, the "arrangements" discussed in the Kirberg patent refer to the overall arrangements of the vending machines in which the coin-storing means 9 are installed (*see*, e.g., col. 1, lines 1, 25, 41, 54; col. 2, lines 37-38, 48-51). The "arrangements" mentioned in the Kirberg patent do not refer to different arrangements of coin tubes in a cassette. Indeed, the Kirberg patent does not even refer to the use of coin tube cassettes. It only refers to individual coin tubes 9.

Applicant acknowledges that the Winstanley patent discloses that different coin tube cassettes may have different arrangements of coin tubes. However, that patent does not provide the features missing from the Kirberg patent, and in particular, does not disclose or suggest the use of a keypad (or similar structure) for any purpose. Therefore, even if there were some motivation to combine the disclosures of the Kirberg and Winstanley patents, such a combination would not result in the subject matter of the pending claims.

In view of the foregoing remarks, applicant respectfully requests reconsideration and withdrawal of the rejections of the claims.

Applicant : Fletcher et al.
Serial No. : 10/646,400
Filed : August 22, 2003
Page : 6 of 6

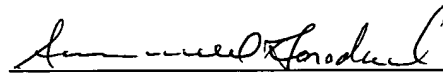
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Respectfully submitted,

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